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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,755	03/30/2005	Emmanuel Miette	Q86678	1578

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EXAMINER	
EPSTEIN, BRIAN M	

ART UNIT	PAPER NUMBER
3628	

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03/16/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/529,755	MIETTE, EMMANUEL	
	Examiner	Art Unit	
	BRIAN EPSTEIN	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20081015 and 20090223*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-16* is/are pending in the application.

4a) Of the above claim(s) *13 and 15* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12, 14, and 16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20050330* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20050330*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, Claims 12, 14, and 16 in the reply filed on February 23, 2009 is acknowledged. Therefore, claims 1, 14, and 16 are currently pending in this application.

2. Claims 13 and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 23, 2009.

Response to Amendment

3. Examiner has reviewed applicants IDS filed March 30, 2005 including those references which were lined through in examiners first action on the merits in this application, which was mailed on April 15, 2008 and has considered the art therein. Examiner thanks applicant for providing additional copies of the non-US patent references.

4. The objection of claim 11 and rejection of claims 1-11 under 35 U.S.C. §112-1st Paragraph are deemed moot since applicant has canceled those claims to which examiner applied the above rejections. Therefore, examiner hereby withdraws the objection of claim 11 and rejections of claims 1-11 under §112-1st paragraph.

Response to Arguments

5. Applicant's arguments with respect to *new* claims 12, 14 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines.'); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').[7] A claimed process involving a fundamental principle that uses a particular

machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008)).*

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus and further, fail the second prong of the new Federal Circuit decision since they do not transform the underlying subject matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al. (US 2004/0065598) as Vaghi (2004/0064326).

11. As per **claims 12, 14, and 16**, Ross teaches a method, system and machine for processing postal items in which an image is formed of each item in a sorting machine, the image including address information, and on the basis of the image of the item and a reference address base, OCR is used to perform automatic recognition of the destination address information to forward each item towards a sorting output of the sorting machine, and in which if said destination address for a current mail item is not recognized unambiguously, said method comprises the steps of:

a. identifying several delivery points from results of said recognition processing for said current mail item, said delivery points corresponding to different ambiguous solutions of said recognition processing results (Paragraph 0010; Paragraph 0018; Paragraph 0026; Paragraphs 0030-0031).

Ross does not explicitly teach, detecting if said delivery points are included in a single delivery round by querying a database recording several ordered lists of delivery

points corresponding respectively to several delivery rounds, and; in response to said detection, computing a volume mail data for delivery range of said single delivery round and comparing said volume mail data to a threshold value to forward said mail item towards a sorting output.

However, Vaghi teaches a similar method, system and machine, and the method, system and machine of Vaghi indeed includes, detecting if said delivery points are included in a single delivery round by querying a database recording several ordered lists of delivery points corresponding respectively to several delivery rounds (Paragraph 0086) (Vaghi teaches detecting if the delivery points are included in a single zip code, which is a single delivery round, by querying a database of a plurality of zip codes / addresses that the mail sorting machine uses to determine the mail pieces zip code), and; in response to said detection, computing a volume mail data for delivery range of said single delivery round and comparing said volume mail data to a threshold value to forward said mail item towards a sorting output (Paragraphs 0089-0090) (Vaghi teaches after detecting if the mail pieces are in the same zip codes, computing the volume of mail for the zip code, comparing the volume to a minimum number, and then forwarding the mail if the volume meets or exceeds the minimum number).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated, detecting if said delivery points are included in a single delivery round by querying a database recording several ordered lists of delivery points corresponding respectively to several delivery rounds, and; in response to said detection, computing a volume mail data for delivery range of said single delivery round

and comparing said volume mail data to a threshold value to forward said mail item towards a sorting output., in accordance with the teachings of Vaghi, in order to reduce the postage costs of the routed mail pieces of Ross by presorting, since so doing could be performed readily and easily by any person of ordinary skill in the art with neither undue experimentation, nor risk of unexpected results.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. **Examiner's Note**: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN EPSTEIN whose telephone number is (571)270-5389. The examiner can normally be reached on Monday-Thursday 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. E./
Examiner, Art Unit 3628
March 12, 2009

/John W Hayes/
Supervisory Patent Examiner, Art Unit 3628